

**REMARKS**

**I. Status of the Application and Claims**

With entry of this amendment, claims 19-82 are pending in the application. Claims 19-81 have been rejected. Applicants have amended claims 19, 57, 64, and 74 to add the language that “wherein the at least one fatty liquid alcohol contains no more than one hydroxyl group.” Support for this language is found in the specification at, for example, page 8, lines 24-28, wherein various liquid fatty alcohols of the present invention, are exemplified and each liquid fatty alcohol species disclosed contains no more than one hydroxyl group. Applicants have amended claim 55 to more clearly describe the scope of their invention for that claim. Support for the amendment to claim 55 is found in the specification, for example, in the original claim 14.

New claim 82 includes the language “wherein the at least one fatty liquid alcohol is present in an amount ranging from 1.5 % to 10% by weight of the total composition.” Support for claim 82 is found, for example, in original claim 8, which discloses various ranges of the fatty alcohol including between 0.5% and 10% by weight, and between 1.5% and 3% by weight. One of ordinary skill in the art would know that these ranges, with their upper and lower limits, includes ranges having the same upper and lower limits that encompass any subset of the broadest range.

**II. Indefiniteness Rejection Under 35 U.S.C. § 112, Second Paragraph**

The Office rejected claim 55 under 35 U.S.C. § 112, second paragraph, as allegedly being “vague and indefinite because as claimed the limitation [a C<sub>16</sub>-C<sub>40</sub> fatty acid chosen from 18-methyleicosanoic acid] is reciting genus selecting from a species.” Office Action at page 2.

Applicants disagree with the rejection. Nevertheless, in order to advance prosecution of the application, and without acquiescence, Applicants amend claim 55 to recite “the composition according to claim 54, wherein said at least one additive is 18-methyleicosanoic acid.” Support for the amended claim is found, for example, in claim 14 as originally filed.

Applicants respectfully request reconsideration and withdrawal of the rejection.

### **III. Rejection under 35 U.S.C. § 102(a)**

Claims 19, 20, 27-29, 32, 33, 52-54, 56-58, 64-66, and 72-76 were rejected under 35 U.S.C. § 102(a) as being anticipated by *Bergmann*, U.S. Patent No. 6,110,450 (“*Bergmann*”). Office Action, page 3. Claims 21-26, 30, 31, 34-51, 55, 59-63, 67-71, and 77-81 were not included in the rejection. The Office asserts that *Bergmann* discloses hair care compositions comprising ceramide, cationic surfactant, and fatty alcohols in a cosmetically acceptable medium. *Id.* In particular, the Office points out that *Bergmann* discloses compositions containing phytantriol, which the Office alleges is “a liquid fatty alcohol”. *Id.*

Applicants disagree with the rejection. In order to advance prosecution of the application, and without acquiescence, Applicants amend claims 19, 57, 64, and 74 to recite the language “wherein the at least one fatty liquid alcohol contains no more than one hydroxyl group.”

Phytantriol is a C<sub>20</sub> branched chain fatty triol, comprising three hydroxyl groups. Independent claims 19, 57, 64, and 74, and claims dependent thereon, recite that “the at least one fatty liquid alcohol contains no more than one hydroxyl group” and thus are

not anticipated by *Bergmann's* composition that comprises a fatty liquid alcohol containing three hydroxyl groups.

In regards to new claim 82, this claim recites the language “wherein the at least one fatty liquid alcohol is present in an amount ranging from 1.5 % to 10% by weight of the total composition.” *Bergmann* discloses using 0.001 to 1% of phytantriol with 0.001 to 1% of ceramides (Office Action, page 3; and col. 7, lines 39-45.) *Bergmann* does not disclose using phytantriol or liquid fatty alcohol at a concentration ranging from 1.5% to 10% by weight in their composition. Accordingly, *Bergmann's* composition does not anticipate instant claim 82.

Applicants respectfully request reconsideration and withdrawal of the rejection.

#### IV. Rejections under 35 U.S.C. § 103(a)

##### *Bergmann* in view of *Maubru*

The Office has rejected claims 21-26, 34, 59, 60, 67, 68, and 77-79 under 35 U.S.C. § 103(a) as being obvious over *Bergmann* as applied to claims 19, 20, 27-29, 32, 33, 52-54, 56-58, 64-66, and 72-76 as above, and in view of *Maubru et al.* (U.S. Patent No. 6,312,674 B1) (“*Maubru*”); Office Action, pages 4-5. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, an Examiner must show that (1) the combination of references would teach or suggest all of the recited claim limitations to one of ordinary skill in the art, (2) there is some motivation in the art to combine the cited references, and (3) there must be some expectation of success in doing so. In the present case, the Office has failed to make a *prima facie* case of obviousness because none of these criteria have been met.

*Bergmann* discloses a composition that comprises phytantriol, allegedly a fatty liquid alcohol, which contains three hydroxyl groups. In view of the present amendment, independent claims 19, 57, 64, and 74, and claims dependent thereon, recite that “the at least one fatty liquid alcohol contains no more than one hydroxyl group.” *Maubru* does not cure this deficiency. The combination of references do not teach or suggest a composition that comprises a fatty liquid alcohol that contains no more than one hydroxyl group, at least one ceramide compound, and at least one cationic surfactant. Accordingly, the combination of references fails to teach or suggest all the recited claim limitations. Applicants respectfully request reconsideration and withdrawal of the rejection for at least this reason.

In addition, Applicants submit that the Office has not provided clear and particular evidence that one of ordinary skill in the art would have been motivated to make the modifications suggested by the Office. *Bergmann* teaches that their ceramide or glycosceramide composition requires the phytantriol species to achieve the desired hair treatment and protection properties. Col. 1, lines 27-45. Further, *Bergmann* teaches that “the combination is believed to have synergistic effect which is not simply the addition of the properties of the two components.” *Id.*, lines 37-40. Moreover, *Bergmann* does not teach or suggest any possible replacements or substitutes for phytantriol. See cols. 1, 2, and 5-7. Accordingly, there would have been no motivation or reasonable expectation of success of substituting the phytantriol in *Bergmann* with the instant claimed liquid fatty alcohols to achieve the desired properties. There was also no motivation or reasonable expectation of success that adding any fatty alcohol to *Bergmann*’s phytantriol composition would contribute to the desired properties that were already achieved with the addition of phytantriol alone.

Accordingly, the combination of references is not *prima facie* obvious over the cited references. Applicants respectfully request reconsideration and withdrawal of the rejection for at least any one of the above reasons.

*Bergmann in view of Maubru and Dubief*

The Office has rejected claims 35-51, 62, 63, 70, 71, 80, and 81 under 35 U.S.C. § 103(a) as being obvious over *Bergmann* in view of *Maubru*, as applied to claims 19-29, 32-34, 52-54, 56-60, 64-68, and 72-79 above, and further in view of *Dubief et al.* (U.S. Patent No. 6,120,757) ("*Dubief*"); *Id.*, pages 5-6. *Dubief* is cited for the quaternary ammonium surfactants disclosed therein and their use in hair cosmetic compositions. Applicants respectfully traverse this rejection.

Applicants traverse this rejection. Applicants incorporate by reference herein the above arguments traversing the obviousness rejection of *Bergmann* in view of *Maubru*. For these same reasons, the combination of references do not teach or suggest all of the recited claim limitations. As we have noted, the Office has identified no evidence of a teaching, suggestion, or motivation to combine those references, and that there would have been no reasonable expectation of success for such a combination. *Dubief* does not cure these deficiencies.

Accordingly, the combination of references is not *prima facie* obvious over the cited references. Applicants respectfully request reconsideration and withdrawal of the rejection for any one of the above reasons.

*Bergmann in view of Maubru, Dubief, and Critchley*

The Office has rejected claims 30, 31, 61, 69, and 79 under 35 U.S.C. § 103(a) as being obvious over *Bergmann* in view of *Maubru* and *Dubief*, as applied to claims 19-

29, 32-54, and 56-81 above, and further in view of *Critchley et al.* (U.S. Patent No. 5,198,210) ("*Critchley*"); *Id.*, pages 6-7. *Critchley* is cited for disclosing isocetyl alcohol, stearyl alcohol, and cetyl alcohol and their use in cosmetic compositions. Applicants respectfully traverse this rejection.

Applicants submit that the Office has not provided clear and particular evidence that one of ordinary skill in the art would have been motivated to make the modifications suggested by the Office. *Bergmann* teaches that their ceramide or glycosceramide composition requires the phytantriol species to achieve the desired hair treatment and protection properties. Col. 1, lines 27-45. Further, *Bergmann* teaches that "the combination is believed to have synergistic effect which is not simply the addition of the properties of the two components." *Id.*, lines 37-40. Moreover, *Bergmann* does not teach or suggest any possible replacements or substitutes for phytantriol. See cols. 1, 2, and 5-7. Accordingly, there would have been no motivation or reasonable expectation of success of substituting the phytantriol in *Bergmann* with a liquid fatty alcohol disclosed in *Critchley* to achieve the desired properties. There was also no motivation or reasonable expectation of success that adding any fatty alcohol to *Bergmann*'s phytantriol composition would contribute to the desired properties that were already achieved with the addition of phytantriol alone.

*Bergmann* in view of *Ochiai*

The Office has rejected claims 35-51, 55, 62, 63, 70, 71, 80, and 81 under 35 U.S.C. § 103(a) as being obvious over *Bergmann* as applied to claims 19, 20, 27-29, 32, 33, 52-54, 56-58, 64-65, and 72-76 as above, in view of *Ochiai et al.* (U.S. Patent No. 5,587,155) ("*Ochiai*"). *Id.*, pages 7-8. *Ochiai* is cited for the quaternary ammonium

cationic surfactants and 18-methyleicosanoic acid disclosed therein and their use in hair cosmetic compositions. Applicants respectfully traverse this rejection.

Applicants traverse this rejection using the same arguments applied above for overcoming anticipation over *Bergmann*, which arguments are incorporated by reference herein. Nothing in *Ochiai* discloses a fatty liquid alcohol within the scope of the claimed invention. Thus, the combination of references do not teach or suggest all of the recited claim limitations. Moreover, the Office has identified no evidence of a teaching, suggestion, or motivation to combine those references, and that there would have been no reasonable expectation of success for such a combination.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

**CONCLUSION**

In view of the above amendments and remarks, Applicants submit that this application is in condition for allowance. An early and favorable action is earnestly solicited.

Please grant any extensions of time required to enter this amendment and response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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